

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOMINIK SCHUTZ

MAILED

JAN 23 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-0921
Application No. 10/083,079
Technology Center 3682

ON BRIEF

Before CRAWFORD, NAPPI and FETTING, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1 to 11 and 13. Claims 12 and 14 have been found to be allowable by the examiner.

The appellant's invention relates to a vehicle steering wheel with a gas bag module mounted displaceably for actuating a horn (specification page 1). An

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understanding of the invention can be derived from a reading of the claims which are appended to the brief.

PRIOR ART

The prior art reference of record relied upon by the examiner in rejecting the appealed claims are:

Bohn et al. EP 0 945 310 A2 Sep. 29, 1999

REJECTIONS

Claims 1 to 4, 6 to 11 and 13 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Bohn.

Claim 5 stands rejected under 35 U.S.C. §103 as being unpatentable over Bohn.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (mailed November 1, 2004) and the examiner's answer (mailed September 29, 2005) for the reasoning in support of the rejection, and to appellant's brief (filed June 7, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations that follow.

We turn first to the examiner's rejection of claims 1 to 4, 6 to 11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Bohn. We initially note that to support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). The examiner's findings in regard to application of Bohn to claim 1 can be found on pages 2 and 3 of the final rejection. We note that the examiner makes specific reference to the disclosure of U.S. Patent No. 6,312,012, which corresponds to the European Bohn reference upon which the rejection is based, because U. S. Patent 6, 312, 012 is in English.

Appellant argues that Bohn does not describe guides that "are tilted by an amount allowed by a yielding of said foam casing" upon laterally pressing down of the covering cap as is recited in claim 1, from which claims 2 to 11 depend and claim 13.

It is the examiner's view that although Bohn does not explicitly describe guides that tilt upon the lateral pressing down of the covering, the guides 10 of Bohn depicted in Figure 1 and guides 26 inherently tilt upon the lateral pressing down of the covering 6 .

The examiner is correct that the prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d at 631-33, 2 USPQ2d at 1052-54.

However, it is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Continental Can Co. v. Monsanto co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (F3d. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990). Inherency, however, can not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Id at 1269, 20 USPQ2s at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

In the instant case the examiner argues (1) that since the guides are in contact with foam casing 4, there will be some tilting upon lateral pressing down of the covering cap, (2) that Bohn teaches that tabs 17 and mounting plate 30 in Figure 2 tilt and if tabs 17 and mounting plate 30 tilt, the guides 26 will tilt as well, (3) that the guides 10 and 26 in Bohn will tilt if enough force is applied and (4) that appellant's have admitted that the guides tilt.

The examiner is correct that the guides 10 depicted in Figure 1 and guides 26 depicted in Figure 2 do contact foam casing 4. However, while this contact with foam casing 4 *may* lead to the tilting of the guides 10 and 26 upon lateral pressing of the covering cap, the examiner has not established that this is *necessarily* the case and thus the disclosure in Bohn that the guides 10 and 26 contact the foam casing is not sufficient to establish a prima facie case of anticipation.

Similarly, while the tilting of tabs 17 and mount 30 may result in the tilting of the guides 26, the examiner has not established that this is *necessarily* the result.

While the examiner may be correct that the guides 10 and 26 will tilt if enough force is applied such force would likely destroy the Bohn mechanism and as such the capability to tilt upon such force is not sufficient to establish a prima facie case of anticipation.

We do not agree with the examiner that the appellant has admitted that the guides 10 and 26 tilt. The examiner finds this admission in the amendment filed by the appellant on July 30, 2003 (see final rejection on pages 8 to 9). The appellant admits that the mounting tab 17 (not guides 10 and 13) may be tilted to actuate the horn. In addition, the appellant contends that the guides 10 would not tilt even if a large force is applied to the covering cap but that rather in that case the upper portion of the bolt 10 will yield before the guides tilt. In our view, such is not an admission that the guides of Bohn tilt upon lateral pressing of the covering cap.

In view of the foregoing, we will not sustain this rejection.

We will likewise not sustain the examiner's rejection of claim 5, which is dependent on claim 1, under 35 U.S.C. § 103 as being unpatentable over Bohn because in our view Bohn does not disclose nor does it suggest guides that tilt upon laterally being pressed down.

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The decision of the examiner is reversed.

REVERSED

MURRIEL E. CRAWFORD
Administrative Patent Judge

~~ROBERT E. NAPPI~~
Administrative Patent Judge

ANTON W. FETTING
Administrative Patent Judge

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